

REMARKS

Claims 19-24, 26, 28-40, and 42-46 will be pending in this application after the Examiner enters the forgoing amendment.

The Examiner objected to the Abstract. Applicants have amended the Abstract to address the objection by the Examiner.

The Examiner rejected claims 19, 29, and 43 under 35 U.S.C. § 112, second paragraph, “as failing to set forth the subject matter which applicants regard as their invention”:

Evidence that claims 29, 43 fail to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 1 filed 4/29/1999. In that paper, applicant has stated that the invention is about “a computer system configuration and method for processing discount information in a retail store.”, and this statement indicates that the invention is different from what is defined in the claim(s) because there is no such subject matter’s limitations in the bodies of those claims . . .
(Office Action, pages 3-4)(emphasis in original)

Applicants respectfully submit that this rejection under § 112, second paragraph, should be withdrawn, since applicants’ statement on page 1 of the specification, is that the “invention relates generally to a store and, more particularly to a computer system configuration and method for processing discount information in a retail store.” (specification filed April 29, 1999, page 1, lines 4-5). First, to say that an invention “relates” to something is not the same as saying the invention is limited to something, and the rejection under § 112, second paragraph, should be withdrawn for this reason alone. Second, the “content of applicant's specification is not used as evidence that the scope of the claims is inconsistent with the subject matter which applicants regard as their invention . . . agreement, or lack thereof, between the claims and the specification is properly considered only with respect to 35 U.S.C. 112, first paragraph; it is irrelevant to compliance with the second paragraph of that section.” Manual of Patent Examining Procedure (MPEP) 2172, II.

The Examiner stated that claims 19 and 35 “are also indefinite with claims’ last paragraph containing “. . . the with third signals read.” (Office Action, page 4)(emphasis in original). Applicants have amended claims 19 and 35 to invert the word order resulting in the informality in those claims.

The Examiner stated that the term “third signal” is not correctly used in claim 29, reasoning that “such card memory is a passive device, it does not have an “active” signal (as called “third signal”).”(Office Action, page 4)(emphasis in original). Applicants do not understand what the Examiner means by “passive device” and “active” signal in this context, since those terms do not appear in the claims. In any event, applicants understand the term “signal” to be a broad one, encompassing a function, or an embodiment of a message.

The Examiner stated that, “claiming signal path as a limitation is a non-statutory subject matter,” regarding claims 32 and 29. (Office Action, page 4). Applicants, submit, however, it is well established that the issue of statutory subject matter of a particular claim can only be resolved by considering the claimed subject matter as a whole. As the Examiner apparently has not considered either of claims 32 and 29 as a whole in reaching his conclusion of non-statutory subject matter, any rejection as non-statutory subject matter must be withdrawn.

The Examiner rejected claim 43 under 35 U.S.C. § 112, second paragraph, stating, “there are insufficient antecedent basis for” the recited “third signals.” (Office Action, page 5). Although applicants disagree with the Examiner in this regard, applicants have amended claim 43 to address this rejection by the Examiner.

The Examiner stated, “claim 35 contains unclear/vague limitation (e.g. in line 4, it says “and for generating second signals” so that it can not be said the limitations are happening sequentially

or simultaneously (e.g. generating ₁st signal, and generating ₂nd signal, in this way it is assumed that simultaneous steps are performed). The word “for” in this limitation is confused. The word “with” in the sentence “the with third signals read in the respective one of the cash register stations” does not have any meaning. Moreover, the plurality form of “generating first signals”, “generating second signals”, “reading third signals”, are confused because preceding terms “first”, “second”, and “third”, and the order of these signals.”(Office Action, pages 5)(emphasis in original). Applicants have amended claim 35 to address the Examiner's concern regarding the words “for” and “with”. Applicants note that claim 35 is not limited to generating first and second signals sequentially, and is not limited to generating first and second signals simultaneously. The terms “first”, “second”, and “third” do not necessarily denote an order. Although the Examiner stated “claim 35 contains unclear/vague limitation,” applicants respectfully remind the Examiner that “[b]readth of a claim is not to be equated with indefiniteness.” MPEP 2173.04

The Examiner rejected claims 19, 29, 35, 43 under 35 U.S.C. §112, second paragraph, “as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (the use of a computer system in this application) . . . Viewing as a whole, those independent claims must include a computer system (or a computer—implemented method) for operating claimed means/steps (see at least the specification for using of a computer system in this application.” The Examiner rejected claims 20-24, 26, 28, 30-34, 36-40, 42, and 44-46 under 35 U.S.C. § 112, second paragraph “because they are dependent on their parent claims.” (Office Action, pages 5-6). Applicants respectfully submit, however, that this rejection under § 112, second paragraph, is improper, because the “content of applicant's specification is not used as evidence that the scope of the claims is inconsistent with the subject matter which applicants regard

as their invention” MPEP 2172, II.

The Examiner stated, “In a broad reasonable interpretation, all the claims direct to a way of communicating between a computer and a scanning device. Therein, delivered messages are responded correspondingly to the predetermined content from computer devices . . . Claim 43 is the most complex/sophisticated claim; it covers all limitations of independent claims (19, 29, and 35) although claims’s language is different). Therefore, the rationale for rejection of claim 43 are obviously applied for above-mentioned independent claims.” (Office Action, pages 6-7). Applicants respectfully submit, however, that this statement by the Examiner regarding “all the claims direct to” - and claims 43, 19, 29, and 35 - is gratuitous and without stated foundation. Claim construction must begin with the language of the claim itself.

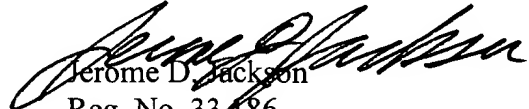
If there are any other fees required for entry of this amendment, or for any other reason, please charge such fees to the undersigned attorney's Deposit Account No. 10-0077.

If the Examiner has any questions about this amendment, applicant's representative would appreciate discussing this amendment with the Examiner. Applicant's representative,

Jerome Jackson, can be reached at 703-684-4840.

Attached is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

Respectfully submitted,


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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE ABSTRACT OF THE DISCLOSURE:

Paragraph beginning at line 60 of page 2 has been amended as follows:

~~Disclosed are~~ computer system configurations and methods for a retail store. In an exemplary
system, a CPU and program in a checkout station make a list of the products selected by the
customer. The CPU and program processes paper coupon information in the context of the
selected products to determine discount eligibility. Another CPU and program in the checkout
station perform electronic coupon redemption, by processing the selected products in the context
of electronic coupon information.

IN THE CLAIMS:

The claims have been amended as shown below, with text being added by the instant amendment shown underlined and text being deleted by the instant amendment enclosed in brackets (“[. . .]”).

19. (Amended) A system for operating with a plurality of portable cards each having a card memory, and a store having a plurality of products, the system comprising:

a plurality of cash register stations, each cash register station including

an electromagnetic detector for generating first signals corresponding to

product pricing and for generating second signals identifying products selected for

purchase;

a card interface for reading third signals corresponding to product pricing from the card memory of one of the portable cards;

a first processing unit that executes a first program in a first memory to correlate second signals with first signals,

wherein the system also includes a plurality of second processing units, each second processing unit executing a second program in a second memory, to correlate second signals from the electromagnetic detector, in a respective one of the cash register stations, with the [with] third signals read by the card interface, in the respective one of the cash register stations.

35. (Amended) A method for a system including a plurality of portable cards each having a card memory, and a store having a plurality of products, and a plurality of cash register stations, the method comprising:

generating first signals corresponding to product pricing and [for] generating second signals identifying products selected for purchase;

reading third signals corresponding to product pricing from the card memory of one of the portable cards;

executing a first program in a first memory to correlate second signals with first signals, wherein the method also includes executing a second program in a second memory, to correlate second signals generated in a respective one of the cash register stations, with the [with] third signals read in the respective one of the cash register stations.

43. (Twice Amended) A method for a system including a plurality of portable cards each having a card memory for storing product discount information, and a store with a plurality of products, the method comprising:

generating first signals corresponding to product pricing;

generating second signals identifying products selected for purchase;

generating third signals by reading from the card memory of one of the portable of cards;

executing a first program in a first memory to correlate second signals with first signals,

sending a device signal on a signal path between a peripheral device and the first program,

executing, responsive to the device signal, a second program in a second memory, to correlate second signals with third signals [from the card memory of one of the plurality of card], wherein the step of executing a first program determines a total amount due by receiving a fourth signal from the step of executing a second program.